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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

06502.0374

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Signature _____

Typed or printed
name _____

Application Number

10/028,375

Filed

12/28/2001

First Named Inventor

Guy L. Steele, JR.

Art Unit

2193

Examiner

Tan V. Mai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record. 56,249
Registration number _____☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Nathan A. Sloan

Typed or printed name

202.408.4312

Telephone number

9/30/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2193**

PATENT

Customer No. 22,852

Attorney Docket No. 06502.0374-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Guy L. STEELE, Jr.)	Group Art Unit: 2193
)	
Application No.: 10/028,375)	Examiner: Mai, Tan V.
)	
Filed: December 28, 2001)	Confirmation No.: 3351
)	
For: TOTAL ORDER COMPARATOR)	
UNIT FOR COMPARING VALUES)	
OF TWO FLOATING POINT)	
OPERANDS)	

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Office Actions mailed on September 15, 2004, and May 31, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed August 30, 2005, which merely states "[t]he Examiner believes the rejections are proper" (Advisory Action at p. 1). None of the points raised by Applicant in the Request for Reconsideration mailed July 29, 2005 (hereafter "*RFR*") have been addressed by the Examiner.

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-33 remain pending, with claims 1-8, 11, 12, 14-20, 22, 23, 25-28, 30, 31, and 33 being the subject of this Pre-Appeal Brief request for review. In the Final Office Action, the Examiner rejected claims 1-8, 11, 12, 14-20, 22, 23, 25-28, 30, 31, and 33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,995,991 to Huang et al. ("*Huang*"); rejected claims 1-8, 11, 12, 14-20, 22, 23, 25-28, 30, 31, and 33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,931,943 to Orup ("*Orup*"); and rejected claims 1-2, 4-9, 15-17, and 26-28 under obviousness-type double patenting as being unpatentable over claims 1-8, 11, 13, 14, 17, 19, and 20 in copending Application No. 10/035,586 ("*586*").¹

I. The rejection of claims 1-8, 11, 12, 14-20, 22, 23, 25-28, 30, 31, and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* is improper.

The Examiner's rejection contains clear errors and omits essential elements necessary to establish a *prima facie* case of obviousness with respect to claims 1-8, 11, 12, 14-20, 22, 23, 25-28, 30, 31, and 33 based on *Huang*. *Huang* does not teach or suggest each and every element of Applicant's claims, and there is no motivation to modify *Huang*.

Claim 1 recites a combination including, for example,

a first analysis circuit for determining a format of the first floating point operand based upon floating point status information encoded within the first floating point operand;

a second analysis circuit for determining a format of the second floating point operand based upon floating point status information encoded within the second floating point operand

(emphasis added). The Examiner appears to assert that *Huang*'s register 116 (Fig. 4) constitutes the claimed "operand." This is clearly wrong.

¹ Pending the withdrawal of the rejections under 35 U.S.C. § 103(a), Applicant will respond to the double patenting rejection as set forth in M.P.E.P. § 804(I)(B) or § 804.02. Applicant does not request review of this rejection by the Pre-Appeal Brief review board.

Huang specifically distinguishes between a register and an operand, stating “each of the **registers** 116 and 118 has an **operand . . . portion** 116-1 and 118-1.” (*Huang*, col. 6, line 66- col. 7, line 1). Moreover, “**operands** X and Y [are] stored in **operand portions** 116-1 and 118-1 of **registers** 116 and 118.” (*Huang*, col. 7, lines 8-10). Even assuming that tag values x_tag and y_tag correspond to the claimed “status information,” (which Applicant does not concede) the Examiner’s contention that *Huang*’s register 116 containing x_tag 116-2 constitutes the claimed “status information encoded within the . . . operand” is clearly contradicted by *Huang*. See, e.g., *RFR* at pp. 8-11.

Structures such as those taught by *Huang* were acknowledged in the Background section of Applicant’s specification, which states “conditions are typically represented by flags [a form of status information] that are stored in the floating point status register, separate from the floating point operand” (paragraph 025). Claim 1 specifically distinguishes over such structures, calling for “status information encoded within the . . . operand.” See, e.g., Fig. 2 and paragraph 045 of Applicant’s specification.

Accordingly, the Examiner’s position that *Huang*’s register 116 constitutes an operand is a clear error. The separate operand 116-1 and separate tag value 116-2 do not constitute a teaching or suggestion of “status information encoded within the . . . operand,” as recited by independent claims 1, 15, and 26 and required by dependent claims 2-8, 11, 12, 14, 16-20, 22, 23, 25, 27, 28, 30, 31, and 33.

Moreover, the Examiner has neither indicated how *Huang* could be modified nor provided any motivation to modify *Huang* to achieve the claimed combination (see *RFR* at pp. 11-12 and Office Action mailed September 15, 2004 at p. 5). Therefore, no *prima facie* case of obviousness has been established for independent claims 1, 15, and 26. Similar

arguments apply to dependent claims 2-8, 11, 12, 14, 16-20, 22, 23, 25, 27, 28, 30, 31, and 33 (see *RFR* at p. 13 and Office Action mailed September 15, 2004 at p. 6).

Therefore, the rejection of claims 1-8, 11, 12, 14-20, 22, 23, 25-28, 30, 31, and 33 under 35 U.S.C. § 103(a) based on *Huang* is improper. Applicant requests the board of examiners to withdraw this rejection.

II. The rejection of claims 1-8, 11, 12, 14-20, 22, 23, 25-28, 30, 31, and 33 under 35 U.S.C. § 103(a) as being obvious over *Orup* is improper.

The Examiner's rejection contains clear errors and omits essential elements necessary to establish a *prima facie* case of obviousness with respect to Applicant's claims 1-8, 11, 12, 14-20, 22, 23, 25-28, 30, 31, and 33 based on *Orup*. Similar to the discussion of *Huang*, *Orup* does not teach or suggest "status information encoded within the ... operand," as recited by claim 1.

The rejection does not make clear what portion(s) of *Orup* allegedly teaches the claimed "status information." However, even assuming that *Orup*'s tag value constitutes "status information," (which Applicant does not concede) the tag value of *Orup* is not "encoded within the ... operand," as recited by claim 1.

The Examiner appears to assert that *Orup*'s element 84 (Fig. 4) constitutes an "operand," as recited in the claims, which contains tag field 89 (alleged status information). This is incorrect. *Orup* specifically states that element 84 is a register stack, not an operand, and that register stack 84 contains a separate Reg Field 87 for storing an operand and a separate Tag Field 89 for storing a tag (alleged status information). See *RFR* at pp. 3-4). Fig. 4 of *Orup* clearly illustrates that Tag Field 89 (status information) and Reg Field 87 (operand) are separate from each other and stored within register stack 84. This does not constitute a teaching or suggestion of "status information encoded within the ...

operand," as recited by independent claims 1, 15, and 26 and required by dependent claims 2-8, 11, 12, 14, 16-20, 22, 23, 25, 27, 28, 30, 31, and 33.

Moreover, the Examiner has neither indicated how either *Orup* could be modified nor provided any motivation to modify *Orup* to achieve the claimed combination (see *RFR* at pp. 5-6; see Office Action mailed September 15, 2004 at p. 3). Therefore, no *prima facie* case of obviousness has been established for independent claims 1, 15, and 26. Similar arguments apply to dependent claims 2-8, 11, 12, 14, 16-20, 22, 23, 25, 27, 28, 30, 31, and 33 (see *RFR* at pp. 6-7 and see Office Action mailed September 15, 2004 at p. 4).

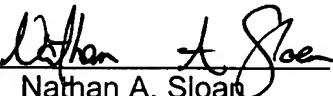
Therefore, the rejection of claims 1-8, 11, 12, 14-20, 22, 23, 25-28, 30, 31, and 33 under 35 U.S.C. § 103(a) based on *Orup* is improper. Applicant requests the board of examiners to withdraw the rejection.

In view of the foregoing, claims 1-33 are in condition for allowance, pending the withdrawal of the double patenting rejection. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2005

By: 
Nathan A. Sloan
Reg. No. 56,249